

## REMARKS

### I. Introduction

The Office Action rejected claims 1-71 under 35 U.S.C. § 103(a) as being unpatentable over Brenner et al. U.S. Patent No. 6,099,409 (hereinafter "Brenner") in view of LaDue U.S. Patent No. 5,999,808 (hereinafter "LaDue") and further in view of the "MOGID: Mobile Geo-Depended Information on Demand" article (hereinafter "the MOGID article"). Applicants respectfully traverse the 35 U.S.C. § 103(a) rejection.

### II. Applicants' Reply to the Office Action

Applicants' independent claims 1, 32, 35, 36, 37, 40 and 41 are generally directed toward interactive wagering on races with a cellular telephone. Racing data on races that have not been run and that a user is allowed to place wagers on are received at the cellular telephone. A user is allowed to select to present the racing data in audio form or visual form, and the racing data is presented on the cellular telephone based on the user selection.

The Office Action admits that neither Brenner nor LaDue teaches "the ability to select to present the racing data in audio form or visual form." (Office Action, page 3). Nevertheless, the Office Action opines that the device profile function in the MOGID article teaches this missing feature and

that it would have been obvious to combine the device profile function of the MOGID article with Brenner and LaDue.

Applicants respectfully disagree, as discussed below.

A.    The MOGID Article Fails to Show or Suggest  
      Allowing a User to Select to Present  
      Received Racing Data In Audio or Visual Form

The MOGID article refers to a GSM based positioning device. Once a device locates its position using a number of GSM antennae, the device connects to the MOGID server, which provides various information to the user based on the user's position. The device may inform the MOGID server of its capabilities using preference data, or a device profile. (MOGID, page 3). The MOGID article defines the device profile as "a collection of information which describes the capabilities, hardware, system software and applications used by someone accessing the MOGID server, as well as particular preferences of the users themselves." Id. The device profile is stored at the MOGID server. Id.

Although the device profiles may include device information indicating whether audio and/or video is supported on a device accessing the MOGID server (or is currently turned on or off), the devices accessing the MOGID server do not allow a user to select to present received information in audio or visual form, as recited by independent claims 1, 32, 35, 36, 37,

40 and 41. For example, using applicants' invention, if the user selects to present the received racing data in visual form, the racing data is presented visually to the user using the cellular telephone (e.g., using the telephone's associated display). If the user selects to present the received racing data in audio form, the racing data is presented audibly to the user using the cellular telephone (e.g., using the telephone's associated speakers).

Although the MOGID article is silent as to exactly how the MOGID server uses the audio on/off and video on/off profile data, it seems likely that this information is used to limit the content transmitted to the user devices. For example, if the video flag is set to "on" and the audio flag is set to "on," then webpages with video and audio content may be transmitted to the device. If a device does not support video (e.g., the device does not have display capabilities), then the video flag may be set to "off," thus informing the MOGID server not to transmit video content to the device. There is no showing or suggestion, however, that the user may select to present received information in either audio or video form, as required by applicants' claimed invention. As explained in the February 8, 2006 Reply to Office Action, the mere ability for a device to receive a certain type of communication — either audio or visual — does not suggest the ability to allow a user

to select to present a particular communication in either of these forms.

Moreover, since the combination of Brenner, LaDue, and the MOGID article fails to show or suggest allowing a user to select to present the racing data in audio or video form, the combination consequently also fails to show or suggest the presentation of the racing data on the cellular telephone based on the user selection, as also required by each of applicants' independent claims.

For at least the above reasons, applicants respectfully submit that the Examiner has misconstrued the MOGID article. It is well established that "to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art" (MPEP § 2143.03). *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). The combination of Brenner, LaDue, and the MOGID article clearly fails to show or suggest at least 1) allowing the user to select to present racing data in audio form or visual form and 2) presenting the racing data on the cellular telephone based on the user selection. Accordingly, the Examiner's rejection under 35 U.S.C. § 103(a) is insufficient as a matter of law.

B. There is Insufficient Motivation to  
Combine Brenner and LaDue with the MOGID Article

Moreover, the Office Action did not provide sufficient motivation for combining Brenner and LaDue with the MOGID article. See In re Rouffet, 149 F.3d 1350, 1355 (Fed. Cir. 1998) ("When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references"). See also MPEP §§ 2142 and 2143.01. The Office Action merely contends that it would have been obvious to combine Brenner and LaDue with the MOGID article "to allow voice service only, video service only, or both audio and video service." (Office Action, p. 4).

However, unlike Brenner and LaDue, the MOGID article is not related to the domain of interactive gaming or wagering. Rather, the MOGID article is only concerned with geographic location techniques using GSM cellular networks. Although the MOGID article includes device profile support to inform the server of device capabilities, one skilled in the art of interactive wagering would not look to the MOGID article for guidance in receiving and presenting racing data using a cellular telephone. Without some objective evidence of a motivation to combine, the obviousness rejection is the "essence of hindsight" reconstruction, the very "syndrome" that the requirement for such evidence is designed to combat, and

insufficient as a matter of law. In re Dembiczak, 50 U.S.P.Q.2d 1614, 1617-1618 (Fed. Cir. 1999).

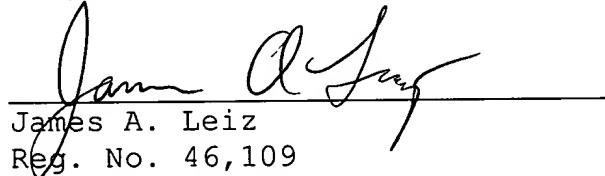
Applicants submit that the only suggestion or motivation for the combination of Brenner and LaDue with the MOGID article is provided by the teachings of applicants' own disclosure. Without a proper motivation for combining the references, the Office Action has "simply take[n] the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability," a practice that is insufficient as a matter of law. Id.; see also In re Lee, 277 F.3d 1338, 1344 (Fed. Cir. 2002) ("[i]t is improper, in determining whether a person of ordinary skill would have been led to a combination of references, simply to use that which the inventor taught against its teacher"). Thus, applicants respectfully submit that their own disclosure has been impermissibly relied on in hindsight to see a suggestion in the MOGID article that simply is not present.

Therefore, for at least the foregoing reasons, applicants submit that independent claims 1, 32, 35, 36, 37, 40 and 41 are allowable over the prior art of record. Claims 2-31, 33-34, 38-39, and 41-71, which include all the limitations of their respective base claims, are allowable for at least the same reasons.

V. Conclusion

For the reasons set forth above, claims 1-71 are allowable over the prior art of record. This application is therefore in condition for allowance. Reconsideration and allowance are accordingly respectfully requested.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "James A. Leiz", is written over a horizontal line.

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